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Attorney Docket No.: PHO 99004CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: *Bennett*

) Art Unit: 2626

Serial No.: 10/653,039

) Examiner: *Martin Lerner*

Filed: August 29, 2003

)

For: *Query engine for processing voice  
based queries including semantic decoding*

)

)

)

TRANSMITTAL OF PHYSICAL COPIES OF REFERENCES  
FOR PREVIOUSLY FILED IDS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

An Information Disclosure Statement was filed in this case on October 21, 2008.

A copy of the same is enclosed.

Due to the large number of references involved, and the large number of applications affected, a Petition was filed by the undersigned to have the PTO waive the physical copy requirement of 37 C.F.R. 1.98, and thus only require a single copy of the references to be submitted in a parent application to the instant application, or alternatively for Applicant to submit electronic copies on a CD ROM or the like. This petition was unfortunately denied (or is presumed to be futile based on rulings in related cases) which result now requires that the Applicant expend additional fees and natural resources providing thousands of pages of redundant materials to the PTO.<sup>1</sup>

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<sup>1</sup> It is indeed incomprehensible that the Petitions Office did not consider the present circumstances as justifying a waiver. In denying the petition the PTO suggested that the Applicant - in lieu of simply making more copies and sending them to the PTO for each of 20 separate files – should instead expend further time and effort uploading these thousands of pages electronically multiple times using the PAIR system. Given the extensive time required, and the serious problems/limitations with the PAIR uploading

While Applicant believes that the original submission and proposal was adequate under the rules, the undersigned is providing further additional copies of the references for each application where necessary to further comply with the requirements of 37 C.F.R. 1.98. This submission is made without prejudice or waiver to contest any later challenge to the propriety of the original submission.

Because of the size of the submission (more than 800 references and nearly 9 thousand pages) it is not possible to fit them into a single box that can be sent using Priority Mail. Accordingly Applicant has had to divide the submission into eight (8) separate parts, consisting of eight (8) separate boxes of materials. Each case, therefore, should have eight (8) separate boxes of materials to be complete.

To assist the PTO in compiling these materials, Applicant has provided a separate list with each box, identifying specifically the materials enclosed by reference to the citation number provided in the October 21, 2008 IDS. This should make review and tracking of the references much easier.

The fees for the underlying IDS were already submitted in October 2008.

Respectfully submitted,



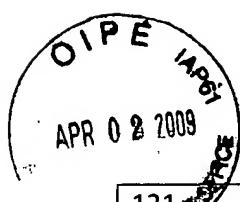
J. Nicholas Gross, Attorney, Reg. No. 34, 175

March 30, 2009  
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**Certificate of Mailing** *x Attachment*  
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope *box* addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450  
*on March 30, 2009* (Date)  
*Anthony Gross*  
Typed or printed name of person signing this certificate  
Signature *Mary Anne*

(..continued)

application (which have been identified to the agency by the undersigned) Applicant respectfully declines such invitation and instead submits physical copies for each case as allowed by the rules.



121	412					Box 5 of 8    3/30/2009
259	525					Serial # 10/653,039
414	420					Docket # 99004CIP
533	607					61 cites on this list
643	629					are enclosed in this box.
736	801					
800	735					
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## CITATION OF PRIOR ART PURSUANT TO 37 CFR 1.97, MPEP 2001.06 AND 37 C.F.R. 1.56

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR 1.97 and in compliance with 37 C.F.R. 1.56, the Patent Owner hereby submits the present citation of prior art. These materials include documents disclosed by Defendants in the ongoing litigation captioned as *Phoenix Solutions, Inc. v. Wells Fargo Bank, N.A.*, No. CV-08-0863 pending in the Northern District of California as identified in the Notice of Concurrent Proceedings previously submitted.

A copy of each reference has been provided pursuant to 37 C.F.R. 1.98(a)(2) and tagged with a citation number that correlates with the enclosed 1449 form. Due to the volume of materials they are being shipped in two (2) separate boxes. Physical copies of the references are only being provided in the pending 10/864,357 case due to the volume of the materials and because it is a parent to several other applications pending to Applicant. As noted below, Applicant is submitting a petition to waive the physical copy requirement of 37 C.F.R. 1.98(a)(2) to avoid costly and wasteful duplication of paper.

The above references are submitted pursuant to 37 C.F.R. 1.97(c). Per the requirements of 1.97(e) Applicant states that they were not known more than three

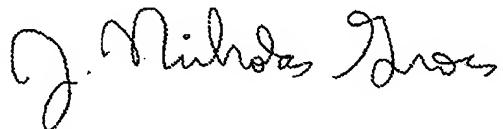
months ago since they were recently provided by representatives of the Defendants pursuant to their disclosure obligations under applicable Local Rules. The Applicant has not made an exhaustive review of the references. They appear to the undersigned, however, to be mostly cumulative and redundant of other references already considered. Hence they are not believed to be material to the claims of the present application. Applicant can offer further insights to the PTO on a case by case basis in an interview should the Examiner decide it is necessary.

No representation or admission is made by Applicant that the attached materials indeed constitute prior art, and/or that they are material in any way to the present claims. They are being disclosed and provided solely to err on the side of caution in complying with the duty of disclosure, and to ensure that the record includes all potentially relevant prior art which was brought to the Applicant's attention during pendency of the present application.

The Examiner is requested to consider the references and initial each entry on the enclosed 1449 form. As an FYI the same IDS is being presented in at least 20 other cases pending before the instant Examiner. As noted earlier, to save paper, space, cost and other undue burden, physical copies are only being provided for now in the earlier 10/864,357 application. Applicant is also petitioning herewith to submit only electronic versions of the references in the present application.

No fees are believed to be due; if the Office determines that the present submission does require some kind of payment, then please charge any petition fees to deposit account no. 501- 244.

Respectfully submitted,



J. Nicholas Gross  
Registration No. 34,175  
Attorney for Applicant(s)

October 21, 2008  
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(510) 540 – 6315 (fax)